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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,332	03/10/2000	Akihiko Mochida	P/16-259	5458

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EXAMINER

WONG, ALLEN C

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 05/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/523,332

Applicant(s)

MOCHIDA ET AL.

Examiner

Allen Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/8/04 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 18, 22 and 26 have been considered but are moot in view of the new ground(s) of rejection.

As for the double patenting rejection of claims 1, 18, 22 and 26, all the applicant needs to do is to send in a terminal disclaimer to overcome the double patenting rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiya (5,178,130) in view of ().

Regarding claim 1, Kaiya discloses an endoscopic imaging system comprising:

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an endoscope having an elongated insertion unit, the elongated insertion unit having an illumination optical system for illuminating an object and an objective optical system for illuminating an object and an objective optical system for introducing an optical image of the illuminated object (fig.1, element 2a);

an imaging apparatus having an imaging device for picking up the optical image and outputting a signal (fig.1, element 4a);

a video processing unit to which said imaging apparatus is removably connected so that it can be disconnected freely and which processes the signal to produce a standard video signal (fig.1, element 32a);

a display for displaying images of said object according to the standard video signal (fig.1, element 5a);

a timing signal generation circuit, incorporated in said imaging apparatus, for generating timing signals used to drive said imaging device (fig.4, element 33a is the same synchronization circuit as element 33a in fig.1, where element 78 is the timing signal generation circuit); and

a phase adjustment circuit for adjusting the phases of the timing signals so as to compensate a signal delay occurring over a signal transmission line to said imaging device which is linked and over which a signal is transmitted (fig.1, element 33a is a phase adjustment circuit; also see col.6, ln.38-52).

Kaiya does not specifically disclose "permitting an operator to manually adjust the phases...." However, Chikama teaches that the phases can be manually adjusted by an operator via a dial or the like (col.7, ln.38-40). Therefore, it would have been

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obvious to one of ordinary skill in the art to combine the teachings of Kaiya and Chikama for clearly viewing crisp, sharp images so as to accurately ascertain the scene or subject being viewed (Chikama col.2, ln.26-30).

Note claims 2-17, 18-21 and 22-25 have similar corresponding elements.

Regarding claim 26, Kaiya discloses an endoscope system comprising:

first and second endoscopes having an elongated insertion unit, each elongated insertion unit having an illumination optical system for illuminating an object and an objective optical system for introducing an optical image of the illuminated object (fig.1, elements 2a and 2b are respective endoscopes);

first and second imaging apparatuses having first and second imaging devices for picking up optical images produced by said first and second endoscopes, respectively, and outputting first and second signals, respectively (fig.1, elements 4a and 4b serve as respective imaging apparatuses);

a video processing unit to which said first and second imaging apparatuses are removably connected and which processes the first and second signals to produce a standard video signal (fig.1, elements 32a and 32b);

a display for displaying images of said object according to the standard video signal (fig.1, elements 5a and 5b);

first and second timing signal generation circuits, respectively incorporated in said first and second imaging apparatuses, for generating timing signals used to drive said imaging devices (fig.4, element 33a is the same synchronization circuit as element

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33a in fig.1, where element 78 is the timing signal generation circuit, also note element 34 has a timing signal generation circuit); and

first and second phase adjustment circuits for adjusting the phases of the timing signals so as to compensate for signal delays occurring over first and second signal transmission lines to said first and second imaging devices which are linked and over which a signal is transmitted (fig.1, elements 33a and 34 are respective phase adjustment circuits; also see col.6, ln.38-52).

Kaiya does not specifically disclose "permitting an operator to manually adjust the phases...." However, Chikama teaches that the phases can be manually adjusted by an operator via a dial or the like (col.7, ln.38-40). Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Kaiya and Chikama for clearly viewing crisp, sharp images so as to accurately ascertain the scene or subject being viewed (Chikama col.2, ln.26-30).

Note claims 27-29 have similar corresponding elements.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 18, 22 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,178,130 in view of Chikama (4,710,807). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim language in the application 09/523,332 is broader than claim 1 of the U.S. Patent No. 5,178,130.

Further, in the present application, the applicant's independent claims 1, 18, 22 disclose a "timing signal generation circuit... to drive said imaging device", and applicant's independent claim 26 discloses the "first and second timing signal generation circuits... to drive said imaging devices." In claim 1, Kaiya (US 5,178,130) discloses a "first and second driving circuits... by applying respectively first and second driving signals to said first and second solid state imaging devices." Clearly, albeit not exact, both the applicant and Kaiya are disclosing similar limitations because the applicant's timing signal generation circuits and Kaiya's driving circuits serve the same purpose, to drive the imaging devices.

Moreover, the applicant's independent claims 1, 18 and 22 disclose a "phase adjustment circuit for adjusting the phases of the timing signals", and applicant's claim 26 discloses "first and second phase adjustment circuits for adjusting the phases of the timing signals". Kaiya's claim 1 discloses "a synchronization controlling means synchronizing the illumination periods of the respective wavelengths". Evidently, one of

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ordinary skilled can clearly acknowledge that the Kaiya's "synchronizing the illumination periods" is basically the same as the applicant's "adjusting the phases of the timing signals" because they both compensate for signal delays.

Although claim 1 of Kaiya (US 5,178,130) does not specifically disclose "permitting an operator to manually adjust the phases...", however, Chikama teaches that the phases can be manually adjusted by an operator via a dial or the like (col.7, ln.38-40). Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Kaiya and Chikama for clearly viewing crisp, sharp images so as to accurately ascertain the scene or subject being viewed (Chikama col.2, ln.26-30).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen Wong whose telephone number is (703) 306-5978. The examiner can normally be reached on Mondays to Thursdays from 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (703) 305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Allen Wong
Examiner
Art Unit 2613

AW
5/5/04


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